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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,429	04/12/2004	Peter Miller	4635-4001US1	4021

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EXAMINER	
MCCORMICK EWOLDT, SUSAN BETH	
ART UNIT	**PAPER NUMBER**
1655	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/823,429	MILLER ET AL.	
	Examiner	Art Unit	
	S. B. McCormick-Ewoldt	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *6-8,16,19 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 9-15, 17-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *May 3, 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Status of Application

The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1655.

Election/Restrictions

Applicant's election without traverse of Group I and the election of species, creatine monohydrate and dextrose, in the reply filed on July 11, 2005 is acknowledged.

Claims 6-8, 16 and 19-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 11, 2005.

Claims Pending

Claims 1-5, 9-15 and 17-18 will be examined on the merits and solely in regards to the species elected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-3, 13-14, the term "derivative" is indefinite because it is not clear what is encompassed by this term. Clarification is needed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller *et al.* (US 6,903,136).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Miller *et al.* (US 6,903,136) teach using creatine monohydrate, cinnamon extract wherein methyl hydroxyl chalcone polymer is derived and a carbohydrate, dextrose, to be used in a dietary or food supplement (column 3, lines 10-11, 25-27; column 5, line 10; column 6, lines 3-14, 42-50; claims 6-7, 13-14, 17-18). Miller *et al.* also teach the amount of creatine dietary supplement ranging from 2 grams to about 30 grams (2000 mg to 30,000 mg) (column 3, lines 31-33) and carbohydrates present from about .5 grams to about .8 grams (500 mg to 800 mg) (column 6, lines 6-14). Thus, Miller *et al.* meet the limitations of claim 1 and 9 as the composition comprises creatine, cinnamon or extract thereof and a carbohydrate and thus anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

> such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5, 9-15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCabe (US 6,172,114), Portman (US 6,051,236) and in view of the Internet website http://www.dcdoctor.com/pages/rightpages_wellnesscenter/dietandnutrition/nutritionguide/nutriguide_weightloss.html.

McCabe (US 6,172, 114) discloses using creatine monohydrate and a carbohydrate in a supplement which is useful in increasing muscle strength and power and reducing body fat (column 1, lines 32-47; column 2, lines 10, 48-50; claims 1, 9 and 11). McCabe does not specifically use dextrose as the carbohydrate.

Portman (US 6,051,236) discloses a nutritional composition that contains a carbohydrate, specifically dextrose, for optimizing muscle performance during exercising (column 11, lines 15-22). In addition, cinnamon is added for flavor (column 13, lines 35-36, 46).

The Internet website http://www.dcdoctor.com/pages/rightpages_wellnesscenter/dietandnutrition/nutritionguide/nutriguide_weightloss.html discloses that cinnamon has been found to metabolize blood sugar. Cinnamon protects against diabetes, reduces hunger and helps control sugar making it easier to control weight.

These references show that it was well known in the art at the time of the invention to use the claimed ingredients in compositions for a diet supplement. It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same

purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re* Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re* Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re* Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Based on the disclosure by these references that these substances are used in compositions for a diet supplement, an artisan of ordinary skill would have a reasonable expectation that a combination of the substances would also be useful in creating compositions to for a diet supplement. Therefore, the artisan would have been motivated to combine the claimed ingredients into a single composition. No patentable invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. See *In re* Sussman, 1943 C.D. 518; *In re* Huellmantel 139 USPQ 496; *In re* Crockett 126 USPQ 186.

The references also do not specifically teach creatine, cinnamon and a carbohydrate in the amounts claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of creatine, cinnamon and a carbohydrate to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

Thus a person of ordinary skill in the art would reasonably expect to use creatine monohydrate, dextrose and cinnamon to be used in a dietary supplement. Based on this reasonable expectation for success, a person of ordinary skill in the art would be motivated to modify the teachings of the references.

Therefore, the invention as a whole would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Summary

No claim is allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

Susan D. Coe
8-18-05
SUSAN COE
PRIMARY EXAMINER